

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD J. GEMRA, RICHARD G. KLUGE,
JOHN A. MURPHY, THEODORE A. SHANKOFF
and BARRY R. VANING

Appeal No. 98-3288
Application 08/630,304¹

ON BRIEF

Before COHEN, ABRAMS and STAAB, Administrative Patent Judges.

COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 and 11. Claims 2, 3, 5 through 8, 10, and 12 through 16, all of the other claims remaining in the application, stand

¹ Application for patent filed April 10, 1996.

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allowed as indicated in the Advisory Action of October 27,
1997 (Paper No. 10).

Appellants' invention pertains to a unitized monocoque enclosure and to an equipment enclosure. An understanding of the invention can be derived from a reading of claims 1 and 11, copies of which appear in APPENDIX A of the brief (Paper No. 13).

As evidence of obviousness, the examiner has applied the documents listed below:

Salmon	4,715,502	Dec. 29, 1987
Nilsson	4,754,369	Jun. 28, 1988

The following rejection is before us for review.

Claims 1 and 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Salmon in view of Nilsson.

The full text of the examiner's rejection and response to the argument presented by appellants appears in the answer (Paper No. 14), while the complete statement of appellants'

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argument can be found in the brief (Paper No. 13).

In the brief (page 5), appellants indicate that claims 1 and 11 stand or fall together. Accordingly, we select claim 1 for

review and focus exclusively thereon, infra. See 37 CFR 1.192(c)(7).

OPINION

In reaching our conclusion on the obviousness issue raised in this appeal, this panel of the board has carefully considered appellants' specification, claims 1 and 11,² the applied patents,³ and the respective viewpoints of appellants

² Read in light of the underlying disclosure (specification, page 7), we understand claim 1 as setting forth "side" sections (i.e. two side sections) to support the claimed recitation of the sections forming a "continuous" corrugated structure.

³ In our evaluation of the applied patents, we have considered all of the disclosure thereof for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

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and the examiner. As a consequence of our review, we make the determination which follows.

We reverse the examiner's rejection of appellants' claim 1. It follows that we likewise reverse the rejection of claim 11 since, as previously indicated, it stands or falls with claim 1.

The unitized monocoque enclosure of claim 1 requires, inter alia, "side, top and bottom panel sections being themselves only of corrugated metal and forming a continuous corrugated structure."

We turn now to the evidence of obviousness.

The patent to Salmon addresses a telephone equipment rack selectively adjustable to widths of 19 or 23 inches. As depicted in Figure 2, for example, the rack comprises integral U-shaped frame members 22 and 24 joined by internally nested upper and lower channel connectors 26 and 28. Each of the

frame members 22 and 24, comprising an upright vertical side channel and top and bottom horizontal channels, is formed from a single bent channel piece.

The Nilsson patent teaches a cabinet that, according to the patentee, is sufficiently strong to withstand specified mechanical stresses, "inter alia vibrations caused by earthquakes" (column 2, lines 36 and 37). The cabinet includes flat frame parts 1, 2 at the top and bottom , respectively. Upstanding fastening cleats 3 are welded to each short side of both frame parts 1 and 2, as depicted in Figs. 1 and 2. The cleats 3 are made from steel sheet material which is pressed into a "corrugated configuration" and welded to one of the frame parts 1 and 2. Two box section end walls 4, each wall made up from an interior steel sheet 7 and an exterior steel sheet 8 welded together, are placed over the cleats 3 and are removably fastened thereto by elements 6 (Figs. 1 and 3).

A collective review of the above evidence of obviousness readily reveals to us that this evidence would not have been

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suggestive of appellants' invention to one having ordinary skill in the art. This conclusion is reached by considering the evidence alone, setting aside what appellants have taught us in the present application. Without the benefit of appellant's teaching, it is clear that the evidence, the Nilsson document, in particular, would clearly have not been suggestive of an enclosure comprising side, top and bottom panel sections being themselves only of corrugated metal and forming a continuous corrugated structure, as required by claim 11. It is for this reason that the rejection on appeal must be reversed.

NEW GROUND OF REJECTION

Under the authority of 37 CFR 1.196(b), this board enters the following new ground of rejection.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as being based upon a specification which lacks descriptive

support for the recitation of "strengthening cleats".

As the record reveals, the recitation of "strengthening cleats" was added to claim 1 (Paper No. 8) subsequent to the final rejection. However, appellants' specification, as filed, only teaches a frame or cabinet without any added internal supports or braces (page 1), without uprights or additional structural or bracing members (page 4), without distinct supporting uprights, legs or other members (page 6), and without separate uprights or supporting frame members, or special struts or internal structural members (page 12).

In light of the above, we find no descriptive support in the original disclosure for the specific negative recitation in claim 1 of a enclosure without "strengthening cleats". The only "cleats" that we are aware of are the upstanding fastening cleats 3 disclosed in the Nilsson reference, earlier discussed. As explained in Ex parte Grasselli, 231 USPQ 393, 394 (Bd. App. 1983), a claimed negative limitation, which does not appear in a specification, as filed, introduces new concepts and violates the description requirement of the first

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paragraph of 35 U.S.C.

§ 112.

REMAND TO THE EXAMINER

In the application file, we have found a patent to Hofman et al. (U.S. Patent No. 5,364,178, issued Nov. 15,1994).⁴ It does not appear that this document has been made of record in the present application. This patent teaches a box-like inner framework 120 (Figs. 3 and 6) comprised of metal corrugated panels, providing a stronger frame which does not rely on an outer housing or wrapping for its structural integrity (column 4, lines 7 through 23, and column 6, line 66 to column 7, line 9). We REMAND this application to the examiner to make this patent of record and to consider the patentability of appellants' claimed subject matter in light of this patent and other known prior art.

In summary, this panel of the board has reversed the

⁴ A copy of this patent is appended to this decision.

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rejection of claims 1 and 11 under 35 U.S.C. § 103 as being unpatentable over Salmon in view of Nilsson. Additionally, we have introduced a new ground of rejection for claim 1 and REMANDED the application to the examiner for the reason indicated above.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

37 CFR

§ 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard

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under § 1.197(b) by the Board of Patent Appeals and
Interferences upon the same record. . . .

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

REVERSED AND REMANDED

37 CFR 1.196(b)

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IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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NEAL E. ABRAMS))
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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